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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/618,569

07/11/2003

Frank Robert Nemirowsky

6555/53773

3771

30505

7590

04/30/2008

Law Office of Mark J. Spolyar  
38 Fountain Street  
San Francisco, CA 94114

EXAMINER

DAGNEW, SABA

ART UNIT

PAPER NUMBER

3688

MAIL DATE

DELIVERY MODE

04/30/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/618,569	<b>Applicant(s)</b> NEMIROFSKY ET AL.	
	<b>Examiner</b> SABA DAGNEW	<b>Art Unit</b> 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11 July 2005</u>  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-9, 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Katz et al (US 6,055,513).

With respect to claims 1 and 7 Katz teaches a system and a method enabling conditional delivery of commerce-related information, comprising:

receiving from a user an identification of a product or service (***Fig. 4, 140, where “caller” reads on user, Fig. 8, 280 teaches ID Col. 2, 44-47, where “item number” reads on identification of product and Col. 25, line 11-22***) , wherein the product or service is the subject of a broadcast;

receiving from the user at least one condition under which the user desires to receive additional information relating to the product or service (***Fig. 7, 242 where teaches collecting inputs for up sale computation and 260 teaches user makes decision and Col. 18, lines 2-15***);

receiving a user identification corresponding to the user (***Col. 21, lines 33-38 and Col. 22, lines 7-10***);

storing the identification of the product or service and the at least one condition in association with the user identification (**Fig. 3, 112 and Col. 16, lines 64-67 and Col. 17, lines 1-2**);

after receiving additional information relating to the product or service, assessing whether the at least one condition is satisfied (**Fig. 7, 242, Fig. 10 and Col. 26, lines 4-11**); and

conditionally providing the additional information to the user, if the at least one condition is satisfied (**Fig. 7, 260, Col. 27, lines 6-21**)

In addition to claim 7, Katz teaches additional limitation of claim 1, wherein a user account database storing use account information associated with plurality of users (**Fig. 6, 330 and Col. 9, lines 65-67 and Col. 10, line 1**); scan the user account database to determine whether the at least one message satisfies the condition imposed by user (**Fig. 10**)

With respect to claim 2, Katz teaches all elements of claim 1. Furthermore, Katz teaches a method further comprising a transaction processing system operative to receive product orders from users (**Fig. 4, 140**) and process payment transactions (**Fig. 5, 210, 212 and 214**) and .

With respect to claim 3, Katz teaches all elements of claim 1. Furthermore, Katz teaches a method further comprising a call center comprising at least one call station assisting a live agent to handle calls from users (**Fig. 3, 40 where teaches call center, 42, live operator, Col. 12, lines 39-44 and Col. 16, lines 23-31**) and .

With respect to claim 4, Katz teaches all elements of claim 1. Furthermore, Katz teaches a method further comprising:

an interactive voice response system to receive and transmit data over a telecommunications network (**Col. 16, lines 52-54 and Col. 26, lines 38-40, where “website” reads on telecommunications network**),

the interactive voice response system providing the interface by which users access the message management module (**Col. 27, lines 22-35**).

With respect to claim 5, Katz teaches all elements of claims 1 and 4. Furthermore, Katz teaches a method wherein the interactive voice response system includes automatic number identification (ANI) functionality, allowing identification of telephone numbers associated with incoming calls and wherein identified telephone numbers are used to identify users and retrieve user account information from the user account database(**Col. 9, lines 29-42**).

With respect to claim 6 , Katz teaches all elements of claim 1. Furthermore, Katz teaches a method wherein the at least one message is an electronic coupon (**Fig. 9, and Col. 27, lines 16-21**).

Katz addressed the majority of claim 8 limitations in claims 1 and 4. Additionally, Katz teaches a broadcast signal monitoring unit operative to detect message codes in a broadcast signal (**Fig. 9 and Col. 27, lines 2-13, where teaches the existence of the “product/service” reads on message and inherent product identification**).

With respect to claim 9, Katz teaches all elements of claim 8. Furthermore, Katz teaches a method wherein the broadcast signal is a television signal (**Col. 17, lines 23-27**).

With respect to claim 12, Katz teaches all elements of claim 8. Furthermore, Katz teaches a method further comprising a user account database storing user account identifiers in association with at least one message delivery mode preference (**Fig. 6, 332, Fig. 10, and Col. 7, lines 45-51**), and wherein the ad delivery module is operative to deliver the message to each user using the delivery mode specified in a corresponding user account (**Fig. 10 and Col. 27, lines 22-35**).

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 10 is rejected under 35 U.S.C. 103(a) as being obvious over Katz et al (US 6,055,513).

With respect to claim 10, Katz teaches all elements of claim 8, including broadcasting through Internet access, cable, television, direct broadcast, satellite broadcast, e-mail facsimile, and voice mail or otherwise (**Col. 17, lines 23-27**).

However, Katz does not explicitly teach radio signal, it would have been obvious to

one ordinary skill in the art to modify Katz's invention by adding radio broadcasting signal in order to transmit advertisement message to a user.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SABA DAGNEW whose telephone number is (571)270-3271. The examiner can normally be reached on 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. D./  
Examiner, Art Unit 3688

/Donald L. Champagne/  
Primary Examiner, Art Unit 3688